

IN THE

United States

Circuit Court of Appeals,

FOR THE NINTH CIRCUIT.

Herman C. Sommer,
Defendant-Appellant,

vs.

Rotary Lift Company and Peter J.
Lunati,

Plaintiffs-Appellees.

REPLY BRIEF OF APPELLANT.

RAYMOND IVES BLAKESLEE,
KELLY L. TAULBEE,

Title Ins. Bldg., 433 S. Spring St., Los Angeles,
Solicitors and Counsel for Appellant.

FILED

MAR 1 - 1933

PAUL P. O'BRIEN,

CLERK

TOPICAL INDEX.

	PAGE
Opening Statement	3
Law Fully Warrants Order Dismissing Bill, the Facts Being Sufficient	7
Additional Cases Recognizing the Mast, Foos Case Doctrine	19
Specific Examples of Misrepresentation in Appellees' Brief and on Argument.....	31
Conclusion	38

INDEX OF AUTHORITIES.

	PAGE
Arizona Edison Co. v. Southern Sierras Power Co., 17 Fed. (2d) 739.....	23
Becher v. Contoure Laboratories, Inc., 29 Fed. (2d) 31	26
Brill v. Peckham Motor Truck & Wheel Co., 189 U. S. 57	26
Co-operating Merchants' Co. v. Hallock, 128 Fed. 596..	27
Denaro v. McLaren Products Co., <i>et al.</i> , 9 F. (2d) 328	27
Duer v. Corbin Cabinet Lock Co., 149 U. S. 216.....	31
Dupont v. Dennison Mfg. Co., 18 Fed. (2d) 317.....	27
Frye-Bruhn Co. v. Meyer, 121 Fed. 533.....	26
Greist Mfg. Co. v. Parsons, 125 Fed. 116.....	31
Keene v. New Ideas Spreader Co., 231 Fed. 701.....	31
Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485..4, 7	
Meccano, Ltd. v. Wanamaker, 253 U. S. 136.....	27
Pelton v. Williams, 235 Fed. 131.....	24
Ray v. Bunting Iron Works, 4 Fed. (2d) 214.....	30
Rip Van Winkle v. Murphy, 1 Fed. (2d) 673.....	4, 20
Sloan Filter Co. v. Portland Gold Min. Co., 139 Fed. 23	31
Smith v. Vulcan Iron Works, 165 U. S. 518.....	19
U. S. Fidelity & Guar. Co. v. Bray, 225 U. S. 204.....	27
Victor Talking Mach. Co. v. Starr Piano Co., 263 Fed. 82	25
Walker on Patents, 6th Ed.....	28, 29

No. 6847.

IN THE

United States

Circuit Court of Appeals,

FOR THE NINTH CIRCUIT.

Herman C. Sommer,

Defendant-Appellant,

vs.

Rotary Lift Company and Peter J.
Lunati,

Plaintiffs-Appellees.

REPLY BRIEF OF APPELLANT.

OPENING STATEMENT.

At the commencement of the argument on this appeal, appellant asked permission to file a short reply brief. Your Honors did not refuse this request, but asked that appellant's counsel make his argument upon the assumption that such reply brief would not be necessary. Matters developed upon the careful perusal and checking of appellees' brief, which had not been possible within the three days before argument subsequent to its service, and certain developments on the argument, have convinced appellant's counsel of the wisdom and propriety, if not necessity, of presenting such reply brief, and the latter has, therefore, been carefully formulated and reduced to

the smallest possible dimensions and is being filed with the clerk coupled with the request that he obtain Your Honors' permission for its receipt and consideration. Appellant's counsel feels that appellant will be prejudiced unless this course be pursued. Among other reasons is the fact that upon argument counsel for appellees grossly misrepresented the law and state of the authorities when he said that there are no authorities warranting this Court in ordering the bill of complaint dismissed because of invalidity of the Lunati patent in suit. On the contrary, *the Supreme Court has so held* and many cases in this and other circuits justify such procedure. We only ask this Court to do what the Supreme Court has done.

Under the head of Comity there is cited and analyzed, in our opening brief, page 171, the case of *Mast, Foos and Co. v. Stover Mfg. Co.*, 177 U. S. 485. Thus, there is endless authority for this Court doing what appellant requests, to wit, reversing the order of the lower court, *and in addition ordering the bill dismissed because of invalidity of the Lunati patent for want of invention over the prior and analogous arts, as well as for actual anticipation, and, also, as previously urged, for want of infringement.*

The decision of this Court in *Rip Van Winkle v. Murphy*, 1 Fed. (2d) 673, cited at page 9 of our opening brief, is authority supporting the general rule that an appellate court may order a bill in a patent suit dismissed on an appeal such as that at bar. It was so relied upon by us. The Mast-Foos case, *supra*, was relied upon under the doctrine of comity, and also for everything else that it decided, including the finding against validity of the patent in suit, and the confirming of the order of the ap-

pellate court, which in turn ordered the lower court to dismiss the bill *because of want of invention*, in an appeal from an order granting a preliminary injunction.

Furthermore, courts of equity at all times have and retain the power to strike down any patent *suo sponte* when it is made to appear or shall appear that the patent in suit is void, and on this we have cited the law extensively in our opening brief.

Also, we find specific misrepresentations and misstatements and improper matter in appellees' brief which require specific challenging, and are likewise giving attention to the quotations in that brief advanced by appellees.

Mr. Williams, on argument, stated that we had included in our answer no new defenses. About one-half of the prior art patents set up by us were not considered and not pleaded in the Orgill case, the only prior adjudication of the Lunati patent, and in which the court found the question of validity a "close question." Also, the Zimmerman patent we set up, and which negatives any otherwise possible invention by Lunati, allowing full access to the underside of the elevated automobile, was not considered or cited by the Patent Office in the prosecution of the Lunati patent application.

Furthermore, Attorney Williams has conceded clearly, on argument, the want of invention in the Lunati patent. We call attention to the transcript of such argument to be filed with this Court. The attempt of Attorney Williams to demonstrate the genesis of the alleged "invention" of Lunati would have been pathetic could it have been sincere. He stood in front of Your Honors and visualized Lunati, exercised to the point of snapping his

fingers (responsive to "inspiration" wrung from the rise and fall of an hydraulic elevator), and, his face in a glow, exclaiming in substance:— "By golly! I could lift automobiles on that, not only just to lift them but to stand and work under them when lifted (just as one can in using the Zimmerman patent of which the law charges me with notice), *only*, I'll use the single piston just like this elevator I am looking at." And, with face radiant with this sad auto-hypnosis, this man, who imagined a streak of lightning of divine afflatus had struck him, applied for patent, but the "creative act" began nowhere and went nowhere. Attorney Williams conceded on argument that there could be no invention in the "idea" alone of using an old hydraulic lift for another purpose (and that is elementary law), and coupled it up, under continued prodding, with a *stressed* concession, an emphatic and groveling concession, that the *means* of the Lunati patent, constituting the vehicle of this old and unpatentable idea, could have been involved by not only a mechanic, without invention, but by a *most ordinary* mechanic. Were it necessary or not, opposing counsel before Your Honors, as he was forced by fact and law to do, has admitted Lunati invented nothing. There was no conception. Attorney Williams spoke of what he called the literary view of the matter. It would not do for the first paper and pencil effort in a kindergarten.

We should now like to address ourselves specifically to this very important matter, made so important by the misrepresentation of opposing counsel, to-wit, that this court can strike down the Lunati patent upon the obvious want of invention in its disclosures and claimed matter, and order the bill dismissed.

Law Fully Warrants Order Dismissing Bill, the Facts Being Sufficient.

The Supreme Court of the United States has definitely settled the proposition that where an appeal is taken from an order granting a preliminary injunction upon affidavits, the Circuit Court of Appeals may reverse such order and at the same time direct a dismissal of the bill if it be found devoid of equity upon its face, or if the patent is void for want of invention or found anticipated, or if non-infringement be made out. The case to which we refer, and which we included in appellant's opening brief, was decided early in 1900, opinion by Mr. Justice Brown, and since that time has been cited in practically every case dealing with the scope of review upon appeals from the allowance or refusal of injunctions *pendente lite*. The case furthermore is strikingly similar to the case at bar, and for that reason we shall take the liberty to deal with it *in extenso*:

Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 20 S. Ct. 709, 44 L. Ed. 856.

This case came before the Supreme Court on a writ of *certiorari* to review a decree of the Circuit Court of Appeals dismissing a bill in equity for infringement of letters patent, and appealed to that court from an order of the Circuit Court for the Northern District of Illinois granting a preliminary injunction. The decision of the Circuit Court is reported in 85 Fed. 782, and of the Circuit Court of Appeals in 89 Fed. 333. The facts gleaned from these two reports and from the statement of the case made by Mr. Justice Brown speaking for the Supreme Court, are as follows:

The bill, filed by the petitioner, Mast, Foos & Co., was for infringement of letters patent No. 433,531 for an improvement in windmills, granted to petitioner upon an application of one Samuel W. Martin. Motion was thereafter made, upon a showing of *ex parte* affidavits, for a preliminary injunction. It seems that the patent had been previously found valid by the Circuit Court of Appeals for the Eighth Circuit, and a device almost precisely like that of the defendant was held to be an infringement. District Judge Grosscup felt himself constrained to follow that prior adjudication unless the new defenses were so cogent and persuasive as to impress the court with the conviction that had they been presented and considered in the former case, the decision there would have been other than it was. Judge Grosscup did not think that was the case, and proceeded to enter an order for a preliminary injunction against the defendant Stover Mfg. Co., and thereafter an appeal was perfected to the Circuit Court of Appeals for the Seventh Circuit. Circuit Judge Woods delivered the opinion for that court. Appellee, first of all, urged that no review would be made on the issue of validity inasmuch as validity had been sustained by the appellate court for the Eighth Circuit. In respect to such contention, Judge Woods said (89 Fed. 333, p. 336):

“The decisions touching the practice on appeals from interlocutory orders, under the judiciary act of 1891, have not been in entire harmony; but in the recent case of *Smith v. Vulcan Iron Works*, 165 U. S. 518, 17 Sup. Ct. 407, where the decisions touching the subject are collected, the supreme court has defined clearly the scope of the review which the act was intended to authorize. After declaring that

the appeal, which by section 7 of the act may be taken from an 'interlocutory order or decree granting or continuing such injunction,' is an appeal 'from the whole of such interlocutory order or decree, and not from that part of it only which grants or continues an injunction,' the court proceeds to say that the manifest intention of the provision was '*not only to permit the defendant to obtain immediate relief from an injunction, the continuance of which throughout the progress of the cause might seriously affect his interest, but also to save both parties from the expense of further litigation, should the appellate court be of opinion that the plaintiff was not entitled to an injunction because his bill had no equity to support it.*' The comprehensive terms of this expression forbid the suggestion that it does not apply when the appeal is from an order made upon affidavits, and not from a decree ordering both an injunction and an accounting, entered as the result of a hearing upon full proofs. If there is ground for a distinction in that respect, it is in favor of the appeal from a preliminary order made upon *ex parte* and imperfect showings at the commencement of litigation, rather than an appeal from an injunction perpetual in terms granted after a full hearing, which is called interlocutory only because there remains to be taken an accounting, upon which the evidence adduced cannot ordinarily affect the injunction. This being the scope of the appeal, the logical inference would seem to be that every application to a circuit court for an injunction or temporary restraining order should be considered on its merits, and that a ruling or opinion of another court upon any question involved should be given only its just and reasonable weight according to the circumstances. The statute gives the right of appeal; the supreme

court has determined that the review, so far as may be, shall extend to the merits; and it is not consistent to say that the decision of an inferior court must be pronounced on one basis and reviewed on another.” (Italics herein generally ours.)

The court next considered the mechanical aspects of the case, and observed that the substitution of an internal for an external toothed spur wheel in connection with the driving shaft of a windmill, producing only improved effects long known to mechanics to be the result of using that form instead of other forms, involved no invention. In respect to such internal gearing, the court remarked (p. 340):

“* * * It had been in use in windmills side by side with the external wheel, and if, as employed in the Martin combination, it served a use which, in any sense, was new, it was, in the language of the opinion in *Potts & Co. v. Creager*, ‘so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill.’”

In conclusion the court said (p. 340):

“It is not perceived that further proofs are possible of a character to change the result. The decree or order below is therefore reversed, with directions to dismiss the bill for want of equity.”

From this decision of the Circuit Court of Appeals, *certiorari* was taken to the Supreme Court, pursuant to which Mr. Justice Brown upheld the appellate court in the exercise of its powers in holding the patent void for want of patentable invention and in dismissing the bill of complaint. We will now refer to and quote from that

opinion, which has placed the Mast, Foos decision in the enviable classification of leading cases.

The court, through Mr. Justice Brown, first addressed itself to the question of comity. We have dealt with this feature of the case extensively in appellant's opening brief, and will not again refer to it here. The court next undertook a consideration of the features of the patent in suit and the mechanics involved. It appears that the Martin (patentee) combination had previously been used in a large number of mechanical devices for the purpose of converting a rotary into a reciprocating motion, as was evidenced in several prior art patents, but had not been used for such purpose in windmills. In referring to this proposition and to the patentee Martin, we can do no better than to quote the court directly, (177 U. S. 485, p. 493):

“Having all these various devices before him, and, whatever the facts may have been, he is chargeable with a knowledge of all pre-existing devices, did it involve an exercise of the inventive faculty to employ this same combination in a windmill for the purpose of converting a rotary into a reciprocating motion? We are of opinion that it did not. * * * Martin, therefore, discovered no new function, and he created no new situation, except in the limited sense that he first applied an internal gearing to the old Mast-Foos mill, which was practically identical with the Martin patent, except in the use of an internal gearing. He invented no new device; he used it for no new purpose; he applied it to no new machine. All he did was to apply it to a new purpose in a machine where it had not before been used for that purpose. The result may have added to

the efficiency and popularity of the earlier device, although to what extent is open to very considerable doubt. In our opinion this transfer does not rise to the dignity of invention. We repeat what we said in *Potts v. Creager*, 155 U. S. 597, 608, sub nom. *C. & A. Potts & Co. v. Creager*, 39 L. ed. 275, 279, 15 Sup. Ct. Rep. 194, 199: 'If the new use be so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use.' The line between invention and mechanical skill is often an exceedingly difficult one to draw; but in view of the state of the art as heretofore shown, we cannot say that the application of this old device to a use which was only new in the particular machine to which it was applied was anything more than would have been suggested to an intelligent mechanic, who had before him the patents to which we have called attention. While it is entirely true that the fact that this change had not occurred to any mechanic familiar with windmills is evidence of something more than mechanical skill in the person who did discover it, it is probable that no one of these was fully aware of the state of the art and the prior devices; but, as before stated, in determining the question of invention, *we must presume the patentee was fully informed of everything which preceded him whether such were the actual fact or not.* * * *

The court next proceeds to a consideration of the exact question which we have before us, and as to which counsel for appellees was rash enough or sufficiently uninformed, to state that he did not know the question had been decided in any reported case. We shall quote the court directly, so that no misunderstanding or mis-

construction can occur. We urgently invite Your Honors' attention to the following passage, which, we submit, settles a main question with which this present brief deals (pp. 494-495):

"3. One of the principal questions pressed upon our attention related to the power of the court of appeals to order the dismissal of the bill before answer filed, or proofs taken, upon appeal from an order granting a temporary injunction.

"This question is not necessarily concluded by *Smith v. Vulcan Iron Works*, 165 U. S. 518, 41 L. ed. 810, 17 Sup. Ct. Rep. 407, since in that case the interlocutory injunction was granted after answer and replication filed, a full hearing had upon pleadings and proofs, and an interlocutory decree entered adjudging the validity of the patent, the infringement and injunction and a reference of the case to a master to take an account of profits and damages. In that case we held that, if the appellate court were of opinion that the plaintiff was not entitled to an injunction because his bill was devoid of equity, such court might, to save the parties from further litigation, proceed to consider and decide the case upon its merits, and direct a final decree dismissing the bill.

"Does this doctrine apply to a case where a temporary injunction is granted pendente lite upon affidavits and immediately upon the filing of a bill? We are of opinion that this must be determined upon the circumstances of the particular case. If the showing made by the plaintiff be incomplete; if the order for the injunction be reversed, because injunction was not the proper remedy, or because under the particular circumstances of the case, it should not have been granted; or if other relief be possi-

ble, notwithstanding the injunction be refused, then, clearly, the case should be remanded for a full hearing upon pleadings and proofs. But if the bill be obviously devoid of equity upon its face, and such invalidity be incapable of remedy by amendment; *or if the patent manifestly fail to disclose a patentable novelty in the invention, we know of no reason why to save a protracted litigation, the court may not order the bill to be dismissed.* Ordinarily, if the case involve a question of fact, as of anticipation or infringement, we think the parties are entitled to put in their evidence in the manner prescribed by the rules of this court for taking testimony in equity causes. But if there be nothing in the affidavits tending to throw a doubt upon the existence or date of the anticipating devices, and giving them their proper effect, they establish the invalidity of the patent; or if no question be made regarding the identity of the alleged infringing device, *and it appear clear that such device is not an infringement,* and no suggestion be made of further proofs upon the subject, we think the court should not only overrule the order for the injunction, but dismiss the bill. *Gardt v. Brown*, 113 Ill. 475, 55 Am. Rep. 434. This practice was approved by the Chief Justice in a case where the bill disclosed no ground of equitable cognizance, in *Green v. Mills*, 25 U. S. App. 383, 69 Fed. Rep. 852, 16 C. C. A. 516, 30 L. R. A. 90, and by the circuit court of appeals for the sixth circuit in *Knoxville v. Africa*, 47 U. S. App. 74, 246, 77 Fed. Rep. 501, 23 C. C. A. 252, where the question involved was one of law and was fully presented to the court. The power was properly exercised in this case.

“There was no error in the action of the circuit court of appeals, and its decree is affirmed.”

The above quoted passage from Mr. Justice Brown's opinion establishes the doctrine that a circuit court of appeals upon appeal to it from the allowance or refusal of an injunction *pendente lite* upon a showing of affidavits, may and should in order to save the expense of protracted litigation, not only reverse the lower court where justified, *but order dismissal of the bill as well*. Dismissal may be predicated upon any one of the four grounds specified in the opinion above:

1. Where the bill is obviously devoid of equity upon its face and incapable of remedy by amendment.

(Probably does not apply to the instant case.)

2. Where the patent manifestly fails to disclose a patentable novelty in the invention.

(True of the instant case.)

3. Where the patent is anticipated if nothing exists in the affidavits which tends to throw any doubt upon the existence or date of the anticipating things, and which, given their proper effect, establish invalidity of the patent.

(True of the instant case.)

4. Where the patent is not infringed in cases where no question arises as to the identity of the alleged infringing device.

(True of the instant case.)

While we have undertaken to show Your Honors that non-infringement is clearly made out in the case at bar,

and further that the Lunati patent should be declared void because anticipated, we nevertheless particularly stress the fact that the Lunati patent is clearly void for want of patentable invention. Just as the patentee Martin in the Mast-Foos case, supra, was charged with a knowledge of the state of the art when he was said to have created his alleged windmill improvement, so in the instant case Lunati is presumed to have known the state of the elevator and analogous arts when he took therefrom an ordinary elevator of lifting structure or assembly and began to lift automobiles with it. This decidedly is not within the domain of patentable invention, just as in the Mast-Foos case it was held to be no more than an adaptation which any mechanic skilled in the art could have made, *and the fact that none did so before Martin does not change the situation.* On this subject, the following excerpt from the Mast-Foos opinion is controlling (p. 492):

“* * * This is undoubtedly a different use from that to which the Martin combination was put; but the question is, whether there is not such an analogy between the several uses in which this combination was employed as to remove its adoption, in the use employed by Martin, from the domain of invention.”

In fact, the entire Mast-Foos case is so strikingly similar to the case at bar that we will below point out to this court in parallel columns the significant similarities:

<i>Mast, Foos & Co. v. Stover Mfg. Co.</i>	<i>Rotary Lift et al. v. Sommer</i>
Patent infringement suit	Same
Motion for preliminary injunction upon the pleadings and affidavits	Same
One prior adjudication holding patent valid and infringed in other circuit by the circuit court of appeals thereof.	Same (except that the prior adjudication is not from a circuit court of appeals)
Lower court followed prior adjudication notwithstanding new defenses and prior art set up in case before it.	Same
Patent for old assembly put to new and analogous use	Same (only Lunati followed earlier automobile lifts such as Zimmerman patent)
Preliminary injunction ordered	Same
Appeal taken from order granting preliminary injunction	Same
Record consists of pleadings, <i>ex parte</i> affidavits, etc.	Same

Appellant urged appellate court to review case on its merits and particularly determine the issues of infringement and validity.

Same

Appellate court found the patent void for want of invention, reversed the order for a preliminary injunction and ordered the bill dismissed.

Appellant urges same ruling.

Upon *certiorari* to Supreme Court, the Circuit Court of Appeals decree affirmed.

If *certiorari* in this case after dismissal, then most certainly same result would under this case follow.

Also, appellant's answer was in before injunction ordered.

We, therefore, submit, in concluding our discussion of the Mast-Foos case, that it constitutes a direct, positive and complete precedent for Your Honors in deciding this case according to appellant's contention. No further search need be made for other authorities, although, as we shall hereinafter point out, the doctrine of the Mast-Foos case has been recognized and applied by this honorable court, and as well by the appellate tribunals of many of the other circuits. No extended discussion of those cases is needed, nor would be proper in view of the sweeping opinion in the Mast-Foos leading case, and we shall, therefore, do little more than to cite the cases which uphold the doctrine in question.

Additional Cases Recognizing the Mast, Foos Case
Doctrine.

Smith v. Vulcan Iron Works, 165 U. S. 518, 41
L. Ed. 810.

While the above case, previously arising on *certiorari*, did not apparently involve a preliminary injunction on affidavits, the said appeal having been taken from an interlocutory decree granting an injunction and ordering an accounting for profits and damages, nevertheless the Supreme Court did definitely decide that in such a case a Circuit Court of Appeals was warranted, in order to avoid protracted and unnecessary litigation, in considering the case fully on its merits and not only as to the injunction feature of the case and as to which the appeal solely pertained. This court refused to grant a motion brought by plaintiff-appellee to dismiss the appeal so far as it involved any question except whether an injunction should be awarded, and instead this court proceeded with a review of the question of validity and infringement, decided them in favor of the defendant and entered a decree reversing the decree of the lower court in one of the cases constituting the appeal, and in the other and after a rehearing, not only reversed the lower court but ordered the bill to be dismissed. *Certiorari* was denied by Mr. Justice Gray, speaking for the court, and full power was accorded a Circuit Court of Appeals in considering the questions of validity and infringement upon such an appeal. The court said (p. 525):

“In each of the cases now before the court, therefore, the circuit court of appeals, upon appeal from the interlocutory decree of the circuit court, grant-

ing an injunction and ordering an account, had authority to consider and decide the case upon its merits, and thereupon to render or direct a final decree dismissing the bill.”

The above opinion undoubtedly constituted the foundation for the later Mast-Foos, *supra*, decision, and is referred to by us for that particular reason.

(*Ninth Circuit Cases.*)

Rip Van Winkle Wall Bed Co. v. Murphy Wall Bed Co., 1 Fed. (2) 673 (referred to in our opening brief).

The appeal in the above case was heard by Circuit Judges Gilbert, Hunt and Morrow, the last named writing the opinion. Appeal was prosecuted by defendant therein from the grant of a preliminary injunction *pendente lite* by the District Court of the Northern District of California, Third Division, in a suit for infringement of letters patent. This court took the decided view, and over the strenuously urged objections of plaintiff-appellee, that the entire case was before it for determination, and this court thereupon considered the question of infringement, the validity of the patent being uncontested, found that the defendant's device was not within the scope of plaintiff's patent and, therefore, did not infringe, and then reversed the order of the District Court granting the injunction, *and ordered that the bill be dismissed*. It must be remembered that in this case plaintiff's motion for preliminary injunction was decided upon *ex parte* affidavits of the respective parties, just as in the case at bar. And, just as in the instant case, the record was complete enough to warrant and enable the appellate

court to consider the case on its merits. We quote from the able opinion of Judge Morrow (p. 675):

“That rule is, however, subject to the qualification that where the order for the injunction *pendente lite* is entered by the District Court upon a full hearing of the case upon the merits, and the appeal brings up the entire case for determination, the order for the injunction will be reviewed and determined accordingly. *Smith v. Vulcan Iron Works*, 165 U. S. 518, 525, 17 Sup. Ct. 407, 41 L. Ed. 810; *Bissell Carpet-Sweeper Co. v. Goshen Sweeper Co.*, 72 Fed. 545, 558, 19 C. C. A. 25.

“The District judge, in his opinion in the present case, granting the injunction *pendente lite*, said:

“‘The matter has been as fully presented (with full sets of models) upon this motion as it could be upon final hearing. The affidavits, briefs, and oral arguments, have, indeed, been models of ability and exhaustive in scope.’

“The record before us on appeal is in accordance with the statement of the District Judge and the assignments of error bring up the whole case, presenting the single question of infringement.”

In finding non-infringement, Judge Morrow made some observations which are such good law and so strictly applicable and pertinent to the case at bar, on the issue of infringement, that we beg the indulgence of Your Honors in quoting same *in toto* (p. 679):

“‘The public is notified and informed by the most solemn act on the part of the patentee, that his claim to invention is for such and such an element or combination, and for nothing more. Of course, what is not claimed is public property. The presumption

is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this.'

"This rule of law is as applicable to the 'broad idea,' if such there is, as it is to the essential elements of the patent.

"In *McClain v. Ortmyer*, 141 U. S. 419, 423, 12 Sup. Ct. 76, 77 (35 L. Ed. 800), Mr. Justice Brown, delivering the opinion of the Supreme Court, said:

"'Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public. The object of the patent law in requiring the patentee to "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery," is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them. The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it.'

"The 'broad idea' of an opening in the wall wider than the bed, or a lateral shifting of the bed with respect to such opening, has not been claimed by the plaintiff in his patent, and the patent cannot, therefore, be expanded to include either of such elements."

And then Judge Morrow observes what is exactly true in the instant case and which, we submit, releases Mr.

Sommer's hoist from any possible construction contemplated by the claims of the Lunati patent in suit. The essential differences between the Lunati patent structure and the defendant-appellant's hoist become even more essential and important and controlling because of the admitted narrow scope of the said Lunati patent even if valid (p. 679):

“Where a patent depends for its novelty over the prior art upon a single limited feature of construction, the claims cannot be expanded by any doctrine of equivalents to cover a device which lacks that single essential feature.’”

And so, were the Lunati patent valid, it could not be infringed by appellant.

Arizona Edison Co. v. Southern Sicrras Power Co., 17 Fed. (2d) 739.

While the above is not a patent case, it does involve an appeal from an order of the lower court refusing to dissolve an injunction, and the principle is the same. We quote directly from Judge Gilbert's opinion (p. 740):

“The scope of the inquiry on the appeal *is not confined to the question of the exercise of the trial court's discretion*, which is usually decisive on appeals from orders granting or refusing to dissolve interlocutory injunctions. In a case such as we find this to be, an appellate court may properly go farther and consider whether or not the case made by the bill of complaint is of the class of cases in which injunctive relief may be granted; for it is well-settled that, where there is an insuperable objection to the bill, either as to jurisdiction or merits, an appellate court may enter a final decree directing its

dismissal. *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 495, 20 S. Ct. 708, 44 L. Ed. 856; *Harriman v. Northern Securities Co.*, 197 U. S. 244, 287, 25 S. Ct. 493, 49 L. Ed. 739; *U. S. Fidelity Co. v. Bray*, 225 U. S. 205, 214, 32 S. Ct. 620, 56 L. Ed. 1055; *Denver v. New York Trust Co.*, 229 U. S. 123, 136, 33 S. Ct. 657, 57 L. Ed. 1101.”

(Cases From Other Than the Ninth Circuit.)

Pelton v. Williams, 235 Fed. 131 (C. C. A., 6th).

The above was an appeal to the Circuit Court of Appeals for the Sixth Circuit from an order granting a preliminary injunction in a suit for infringement of patent. The court, *per curiam*, recognized its full authority to consider the case on the issues of validity and infringement, but found it unnecessary to review the patent as to validity in view of obvious non-infringement. The court said (p. 132):

“This is an appeal from an order granting a preliminary injunction against appellant for alleged infringement of letters patent No. 873,399, issued December 10, 1907, to appellee. The pleadings, so far as reference to them is necessary, are in the usual form for presenting issues of infringement and validity of the patent in suit. We do not find it necessary to pass upon the validity of the Williams’ patent; for we are convinced that the infringement alleged cannot be sustained. * * *”

The court then proceeded to hold the patent there in suit limited and particularly on the file wrapper in view of certain rejected and abandoned claims, and in dis-

posing of the case and in ordering the bill dismissed, said (p. 134):

“It results that the order of injunction must be reversed and the cause remanded, with instruction to enter an order directing the clerk of the court below to return all moneys received by him from appellant in pursuance of the injunction order mentioned, and also dismissing the bill, with costs. *Smith v. Vulcan Iron Works*, 165 U. S. 518, 525, 17 Sup. Ct. 407, 41 L. Ed. 810; *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 495, 20 Sup. Ct. 708, 44 L. Ed. 856.”

Victor Talking Mach. Co. v. Starr Piano Co., 263 Fed. 82 (C. C. A., 2nd).

The above was an appeal by plaintiff in a patent infringement suit from the refusal of the lower court to grant a preliminary injunction upon motion made therefor. While Circuit Judge Manton did not order a dismissal because of certain peculiar factors in the case, he did recognize the Mast-Foos doctrine as giving him full power to do so in an appropriate case. We quote his words (p. 84):

“* * * But the right of the court to be at liberty to re-examine the former adjudication, and dispose of the question in accordance with its own convictions, should never be denied. *Curtis v. Overman Wheel Co.*, 58 Fed. 784, 7 C. C. A. 493 (Second Circuit, C. C. A.). It is also true that this appellate court, on an appeal from an order granting or denying an injunction, may decide the case upon the merits, and direct a dismissal of the suit, if it is of the opinion that the plaintiff was not entitled to an

injunction because his bill had no equity to support it. *Smith v. Vulcan Iron Works*, 165 U. S. 518, 17 Sup. Ct. 407, 41 L. Ed. 810. This court is not confined in its review of the injunction order to the justice of the denial of the temporary injunction, but it may consider the sufficiency of the defense interposed. *Linde Air Products Co. v. Morse Dry Dock Co.*, 246 Fed. 834, 159 C. C. A. 136.

“The Supreme Court has held that where a bill is devoid of equity, and it so appears upon its face, *or if the patent manifestly fails to disclose patentable novelty in the invention*, a protracted litigation may be avoided, and the appellate court may dismiss the bill. *Mast, Foos & Co. v. Stover Co.*, 177 U. S. 495, 20 Sup. Ct. 708, 44 L. Ed. 856.”

The following cases are submitted with only necessary brief comment as examples of the recognition by courts of the various circuits, and by the Supreme Court, accorded the Mast-Foos doctrine upon appeals from preliminary injunctions:

Becher v. Contoure Laboratories, Inc., 29 Fed. (2d) 31 (C. C. A., 2nd);

Frye-Bruhn Co. v. Meyer, 121 Fed. 533 (C. C. A., 9th);

Brill v. Peckham Motor Truck & Wheel Co., 189 U. S. 57, 47 L. Ed. 706.

The Supreme Court in the above case sent the case back for further proofs, apparently because of the peculiar situation involved, and especially for the reason that the record indicated plaintiffs had no opportunity

before hearing to inspect the *ex parte* affidavits filed by defendants and were granted no leave to rebut them.

Co-operating Merchants' Co. v. Hallock et al., 128 Fed. 596 (C. C. A. 6th);

Denaro v. McLaren Products Co., et al., 9 Fed. (2d) 328 (C. C. A., 1st);

U. S. Fidelity & Guaranty Co. v. Bray, et al., 225 U. S. 204, 66 L. Ed. 1055 (not a patent case, but rule recognized);

Meccano, Ltd., v. Wanamaker, 253 U. S. 136, 40 Sup. Ct. 463.

In the above case Mr. Justice McReynolds said (p. 465 of 40 Sup. Ct. Rep.):

“* * * The power of Circuit Courts of Appeal to review preliminary orders granting injunctions arises from section 129, Judicial Code, which has been often considered. *Smith v. Vulcan Iron Works*, 165 U. S. 518, 17 Sup. Ct. 407, 41 L. Ed. 810; *Mast, Foos & Co. v. Stover Manufacturing Co.*, 177 U. S. 485, 494, 20 Sup. Ct. 708, 44 L. Ed. 856; *Harriman v. Northern Securities Co.*, *supra*; *United States Fidelity & Guaranty Co. v. Bray*, 225 U. S. 205, 214, 32 Sup. Ct. 620, 56 L. Ed. 1055; *Denver v. New York Trust Co.*, *supra*. *This power is not limited to mere consideration of, and action upon, the order appealed from; but, if insuperable objection to maintaining the bill clearly appears, it may be dismissed and the litigation terminated.*”

Dupont v. Dennison Mfg. Co., 18 Fed. (2d) 317 (D. C. N. D. Ill. E. D.).

In the case above, which is not an appeal, District Judge Carpenter followed the drastic but fully warranted

procedure of dismissing the case on motion for preliminary injunction based on a showing of *ex parte* affidavits, because the patent was void on its face for want of invention. The case arose on plaintiff's motion for a preliminary injunction, and as to which defendant moved to dismiss the bill on several grounds, including the ground that the patent was void on its face for lack of patentable novelty and invention, and on which issue the Court determined the entire case, found the patent invalid for want of invention, and in order to save a protracted litigation, quoting from the Mast-Foos case, *supra*, dismissed the bill of complaint at plaintiff's cost.

In conclusion on this point we will quote from the most recognized text authority, *Walker on Patents*, Sixth Edition (Sec. 736, p. 817):

“The Circuit Court of Appeals, on an appeal from an order granting a preliminary injunction, may not only reverse that order, but may also direct the court below to dismiss the bill of complaint. * * *”
(Citing authorities all considered herein.)

Lunati is not in any sense of the word an inventor. We submit that what he did any skilled mechanic, confronted with the same problem, could have done without even the exercise of a moderate amount of ingenuity. Lunati's alleged contribution was to take the old style hydraulic elevator, the purpose of which was to lift and lower objects, and what the objects were is immaterial, and then by eliminating the cage or platform of that elevator, to make the under-structure of an automobile or other vehicle accessible. Even this had been done as in the Zimmerman patent.

Walker on Patents, Sixth Edition, Section 59, page 67, says:

“The United States Circuit Court of Appeals, Third Circuit, in *Pyrene Mfg. Co. v. Boyce et al.*, 292 F. R. 480, 481, stated:

“‘On the major issue of validity we shall first inquire whether the conception for which the patent was granted involves invention. Because of the lack of definite rule, questions of this kind are often perplexing. It is a trite saying that invention defies definition. Yet through long use, the word has acquired certain characteristics which at least give direction to its meaning. Invention is a concept; a thing evolved from the mind. It is not a revelation of something which exists and was unknown, but is the creation of something which did not exist before, possessing the elements of novelty and utility in kind and measure different and greater than what the art might expect from its skilled workers.’

“To be a patentable invention there must be present a creative mental conception as distinguished from the ordinary faculties of reasoning upon materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice by those skilled in the art.”
(Citing cases.)

A mere “idea” is unpatentable.

And following, in Section 60, *Walker* says (pp. 67-68):

“It has been shown that the word ‘discovered,’ in Section 4886 of the Revised Statutes, has the meaning of the word ‘invented.’ It follows that patents are grantable for things invented, and not for things otherwise produced, even where the production re-

quired ability of a high order. Novelty and utility must indeed characterize the subject of a patent, but they alone are not enough to make anything patentable; for the statute provides that things to be patented must be invented things, as well as new and useful things. * * *”

Surely seeing an elevator lift something, and then throwing in some details, which Attorney Williams admitted on argument, could not require the exercise of invention, cannot constitute a patentable invention.

In *Ray v. Bunting Iron Works*, 4 Fed. (2d) 214. this court said:

“The result of the application of the common skill and experience of a mechanic, which comes from the habitual and intelligent practice of his calling, to the correction of some slight defect in a machine or combination, or to a new arrangement or grouping of its parts, tending to make it more effective for the accomplishment of the object for which it was designed, not involving a substantial discovery, nor constituting an addition to our knowledge of the art, is not within the protection of the patent laws.’ *Sloan Filter Co. v. Portland Gold Min. Co.*, 139 F. 23, 71 C. C. A. 460, and cases there cited.

“Nor is there anything new or novel in the combination aside from mere mechanical changes, or changes in machine design. Thus we find the same combination of atomizer and fan in the Mack patent, No. 548,647, issued October 29, 1895, and to some extent in the Klein patent, No. 473,759, issued April 26, 1892. The cases are uniform in holding that there is no invention in merely selecting and fitting together the most desirable parts of different machines in the same art, if each operates the

same in the new machine as it did in the old and effects the same result.

“It is said that appellee’s carrier is not anticipated by any single patent; but it is not necessary to show complete anticipation in a single patent. The selection and putting together of the most desirable parts of different machines in the same or kindred art, making a new machine, but in which each part operates in the same way as it operated before and effects the same result, cannot be invention; such combinations are in the nature of things the evolutions of the mechanic’s aptitude rather than the creations of the inventor’s faculty.’ Huebner-Toledo Breweries Co. v. Mathews Gravity Carrier Co., 253 F. 435, 447, 165 C. C. A. 177, 189.”

See further:

Keene v. New Idea Spreader Co., 231 Fed. 701, 709 (C. C. A. 6th Cir.);

Duer v. Corbin Cabinet Lock Co., 149 U. S. 216, 223, 37 L. ed. 707, 710;

Sloan Filter Co. v. Portland Gold Mining Co., 139 Fed. 23 (C. C. A. 8th Cir.);

Greist Mfg. Co. v. Parsons, 125 Fed. 116, (C. C. A. 7th Cir.).

Specific Examples of Misrepresentation in Appellees’ Brief and on Argument.

We beg leave to tersely and briefly point out the following marked misrepresentations of appellees by brief and argument, which should not be overlooked in determination of the issues before this court.

Appellees’ counsel has never defined the alleged invention of the Lunati patent except to talk vaguely about

putting two *rails* on a single plunger. Of course, there could be no invention over the prior art in putting rails on an hydraulic piston or plunger. Sommer uses no such "rails," that is, the rails of the Lunati patent shown clearly in the prior art in Zimmerman, and upon which the wheels of the automobile are to be rolled. These are the only rails, or else why the wheel chocks on the end? Why any small excavation for a stuffing box unless the rails go down to the earth level? They do not need to go down to that level in appellant's use, where the beams come up under the axles.

In fact, the elevator publication, page 6, Vol. 3 of transcript of record, Book of Exhibits, clearly shows beams on top of an elevator plunger or piston (B) upon which an automobile or any other load may be lifted, between which beams (B) the under-body of the automobile can be serviced. *Preventing* accessibility is a deliberate mechanical act; *permitting* accessibility is a natural condition of parts. No platform is shown in Fig. 3 on this page. Neither the addition of a stop to a plunger nor permitting it to normally rotate, nor permitting accessibility to the plunger load, nor providing a hole in the ground for a packing, could import any possible invention to any such elevator structure, and appellees' counsel has admitted that these things are simply the provisions of an ordinary and not an exceptional mechanic.

As to the Wood patent (Book of Exhibits, p. 201), in spite of attempted distortion of its disclosure, the latter clearly contains a single piston or plunger, in a cylinder, the plunger being rotatable and having a stop, and there being a packing gland around the plunger, and rails being

supported on the plunger. The entire weight of a load can be supported upon the plunger. The Wood plunger moves vertically in either direction. If one small enough to service an automobile were made, all appellees' contentions would fall. The automobile would be lifted—not lowered. No counterweights would be necessary. Putting Zimmerman's two rails on Wood's single piston, which any ordinary mechanic would do without inspiration, gives us what Lunati discloses. There is no possible answer to this statement. It has been in substance admitted.

In addition to the many respects in which appellant's elevator structure does not infringe, it may be pointed out further that the plunger does not fit the cylinder at any zone. Two cast guide rings are fastened inside the cylinder with a working fit for the plunger which they surround and guide. One is near the upper end of the cylinder, the other two feet or so below it. No cylinder packing end is provided, but a packing gland which fits around the plunger is drawn into the top end of the cylinder by bolts passing through it and screwing into nuts welded to the top of the cylinder. This packing is compressed around the plunger between the gland and the upper ring. No excavation for the packing gland is required because it has a smaller diameter than the cylinder. The bars or beams in appellant's device are not parallel, and wheels could not be supported or rolled upon them. They are bent inwardly to the plunger head instead of being straight and supported as in the Lunati patent. Of course, no fluid is forced into and out of the appellant's cylinder. In a novel way his hollow plunger is formed to serve as a fluid chamber in which

compressed air regulates its use. The open bottomed plunger of the Lunati patent *could not be so used*. Appellant does not need to use a recess in the ground to accommodate his packing as he places the packing inside a cylinder. However, such a hole in the ground could import no novelty or invention. Such an arrangement and the stop for the plunger are both old in the prior art as previously pointed out.

Turning to general aspects of misrepresentation in appellees' brief, the actual conditions obtaining are not properly pointed out on page 12. We submit that partner Hinkle's arguments on the merits of a preliminary injunction motion were no worse in substance than those of Attorney Williams, and obviously Attorney Hinkle could have tried the case. It is foolish for appellees to contend that a patent lawyer, constantly practicing his profession for years, and having a coterie of partners, could not try this case as well as any other, or, if not, that one of his partners could not have done so, with eleven whole months after the bringing of the suit within which to prepare. Clearly all that appellees wanted was a preliminary injunction, to choke off the sources of income of appellant so that he could not support the defense of the case by trial.

On page 19 is an unwarranted implication that appellant's counsel had some "*ex parte*" discussion with the court regarding the reference. The reference had been asked in open court again and again, and only the matter of Mr. Lyndon's affidavit, as usable on reference, was referred to in this episode—a mere trivial and incidental matter. We bitterly complain in this case of the repeated

yond the merest and sheerest mechanical skill, particularly over the prior art. We quote as follows (p. 87):

“* * * Never before had parallel vehicle supporting rails been carried and elevated by a single centrally disposed hydraulic plunger to afford access to an automobile underbody. Never before had a single rotatable and vertically movable plunger carried parallel vehicle supporting rails which it could elevate to afford access to the underbody of an automobile.”

On page 109, appellees refer to *Angelus v. Wilson*, a decision of this court, in which present counsel for appellant represented the successful appellees. This case is not in point at all. There there was a broad new underlying combination, and former Judge Hunt so held.

A piece of arrant sophistry occurs at the bottom of page 124. No *ex parte* suggestions of reference were made by appellant's counsel, and there is no such record or foundation for any such untrue statement. Judge Hollzer decided upon this reference after repeated suggestions of it with both counsel present, not only in open court but in chambers.

Inspection of the various charts and inserts in appellees' brief should be very carefully made. The showing therein contained is a strange showing as to comparison and contrast, and the record may far better be resorted to. Such arbitrary *ex parte* tabulated conclusions are not evidence and are not dependable.

CONCLUSION.

In fine, the history of the Lunati patent is of that kind which warrants this court in casting the trade and industry loose from the shackles of an improper and improvidently granted patent monopoly. It is the duty of the Federal courts to protect the rights of workers in the arts as much as to protect the rights of inventors in the art. Lunati was no inventor. By a process of harassing workers in the art and forcing them to their knees in exacting consent decrees, and as a result of a most unwise decision in the Western District of Tennessee, where the court obviously had not made its mind up conclusively, the Lunati patent has been used to suppress fair and honest competition.

Not only did appellant never have a real chance in the lower court, what with delays, interference with due course of procedure by opposing counsel, and making and unmaking of an order of reference and the like, so that he never was given his real day in court on trial, *but* we assert that the result of any such a trial could not be more certain than is the propriety, on the face of the record now before Your Honors, of finding the patent void for want of invention. Neither can appellant infringe. We, therefore, ask that the order be reversed and the lower court ordered to dismiss the bill, both for non-invention and non-infringement. The preliminary injunction order was the direct result of bias, prejudice and abuse of discretion, coupled with disregard of the facts and law, and it ran against all the equities.

Respectfully submitted,

RAYMOND IVES BLAKESLEE,

KELLY L. TAULBEE,

Solicitors and Counsel for Appellant.